



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,644	01/18/2002	Leo Liu	2002630-0012	8744

24280 7590 08/18/2005
CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON, MA 02110

EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT PAPER NUMBER

1633

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/051,644	Applicant(s) LIU ET AL.	
	Examiner Scott D. Priebe, Ph.D.	Art Unit 1633	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

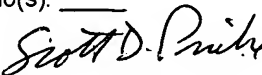
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☒ Newly proposed or amended claim(s) 1-9, 11-13 and 25 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-13, 15-35, 46-53 and 106-142.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): _____.
 13. ☒ Other: See Continuation Sheet.


 Scott D. Priebe, Ph.D.
 Primary Examiner
 Art Unit: 1633

Continuation of 3. NOTE: The amendment of claim 1 raises new issues with respect to claim 10 for recitation of "the nematode secretory product". The amendments to claims 115-118 and 122-128 substantially change the limitations previously presented, which would require new consideration, at least with respect to the written description requirement.

Continuation of 11. does NOT place the application in condition for allowance because: Arguments that rely upon entry of the amendment are moot since the amendment has not been entered. With respect to the written description rejection of claim 46-53, Applicant asserts (Reply, p. 11) that the Examiner has acknowledged that embodiments in which the regulatory region is from a gene encoding a secretory product of *C. elegans* are supported by para. 73 (published application), Examples 4, 8 and 9 and original claims 15-18. Applicant is misconstruing Examiner's point here. The Examiner merely pointed out what the specification teaches, and made no comment as to whether any particular embodiment of the invention of claim 46 was supported by this disclosure. The new matter in claim 46 results from limiting claim 46 to expression in pharyngeal gland or amphid sheath cells. With respect to grounds of rejection that were first raised in the Office action of 3/23/04, whether one of skill in the art, with the specification in hand, is aware of how one might go about making for themselves the elements required to practice the invention as broadly as claimed relates to the enablement requirement, not the written description requirement. Possession of a method for identifying and making a product alone does not demonstrate possession of the product itself. See *Regents of the Univ. of Calif. v. Eli Lilly & Co.*, 43 USPQ2d 1398 (Fed. Cir. 1997) and *Univ. of Rochester v. G.D. Searle & Co.*, 69 USPQ2d 1886 (Fed. Cir. 2004). It is noted that claims 106-142 were also rejected for the reasons set forth in the Office action of 3/23/04 for lack of an inadequate original description, in addition to the new matter issues. For example, claim 106 is not limited to the *C. elegans* vap-1 regulatory region (If proposed claims 106 -109 and 131-136 were limited to the vap-1 regulatory region of the *C. elegans* vap-1 gene, their rejection under 112, first para. would be overcome.) With respect to the enablement rejection, the Office action of 4/6/05 explains why the teachings of the specification are not adequate to enable the breadth of the claims, i.e. embodiments wherein the reporter gene is linked to *C. elegans* regulatory sequences other than that of the vap-1 gene. Applicant's arguments simply summarize what the specification teaches, and do not address the issue any further.

Continuation of 13. Other: The letter filed 01 Aug. 2005 regarding the sequence listing of 18 Jan. 2005 satisfies 37 CFR 1.821(g)..